REMARKS

This amendment is submitted in response to the Examiner's Action dated September 18, 2002, and pursuant to a telephonic interview between Examiner and Applicant's representative. In that telephonic interview, Applicant and Examiner discussed the rational utilized by Examiner when grouping the claims for restriction. Specifically, Applicant argued that the restriction of program product claims as separate from method and system claims that cover the same or similar inventive features was improper. Examiner disagreed and requested Applicant submit the present response outlining the reasons for Applicant's position. Examiner further suggested that he may be persuaded to remove (or modify) the restriction requirement based on the arguments provided by Applicant.

Applicant has canceled, without prejudice, several un-elected claims in response to the restriction requirements. No further amendments to the claims have been made. Where arguments are provided below to rebut the restriction requirement, those arguments are in reference to the original set of claims including those canceled herein.

ELECTION/RESTRICTIONS

At paragraph 1 of the Action, the Examiner requested a restriction to one of the following inventions under 35 U.S.C. 121:

I.   Claims 1-4, drawn to "a method for ensuring the authenticity of electronic documents", classified in class 705, subclass 26.

II.   Claims 5-7 and 11-14, drawn to "An electronic database used as a depository for electronic documents generated during E-commerce transactions" and "A depository for ensuring the authenticity of electronic documents generated during E-commerce transactions", classified in class 707, subclass 6.

III.   Claims 8-10 and 15-18, drawn to "A computer program product", classified in class 703, subclass 21.

Applicant hereby traverses the above restriction requirement where claims having similar elements (or features) are grouped and restricted based solely on the primary class assigned to them

by Examiner. According to 37 C.F.R. §1.142 and Chapter 803 of the MPEP, restriction is proper if there are two or more <u>independent</u> **and** <u>distinct</u> inventions claimed in a single application. Specifically, Chapter 803 states that restriction is proper "only if they are **able to support separate patents** and they are independent... or distinct" (emphasis added).

Chapter 802 of the MPEP provides the standard for determining when claims are "independent" and "distinct." As stated therein, "independent" means "that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, **operation**, or effect." Further, "distinct" means "that two or more subjects as disclosed are related, ... AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER."

As divided by Examiner, the Group I claims are drawn to a method for ensuring the authenticity of electronic documents generated during E-commerce transactions. Claims 11-14 of the Group II claims are drawn to a depository for ensuring ... transactions. Implementation of the steps (or elements) of either of these groups of claims necessarily require program code in/on a medium readable by a processing component of a data processing system.

Claims 15-18 of Group III are drawn to a computer program product, which includes program code for completing similar steps as provided by both Group I claims and Claims 11-14 of Group II. Thus, the program code of Claims 15-18 of the Group III claims provide similar functionality to that provided by the elements of the method and depository claims.

It is clear that the above Group III claims are not patentably distinct from the Group I claims or Claims 11-14 of Group II. Likewise, neither the Group I claims nor Claims 11-14 of Group II are patentably distinct from Claims 15-18 of Group III. Each group of claims provide related/similar functional features (i.e., a computer implemented method, a depository that provides the computer implemented method, and a disk medium that enables the computer implemented method).

If these claim groups were provided in separate patent applications filed on different dates, Examiner would most likely issue a §102 or §103 rejection of one group of claims over an earlier filed, issued patent containing one of the other two groups of claims. Thus, Examiner's restriction requirements fails the second, "distinct" test required for supporting a restriction requirement since the Group I claims and above-referenced claims of Groups II and III are not patentable over each other.
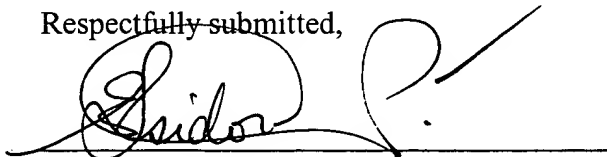
In accordance with the required procedures for responding to a restriction requirement, Applicant hereby elects the Group II claims (Claims 5-7 and 11-14), with traverse. The claims of Groups I and III are not elected and have been canceled.

CONCLUSION

Applicant has diligently responded to the Office Action by electing Group II claims, with traverse, and canceling Groups I and III claims from the application. Applicant has provided arguments herein supporting the traversal of the restriction requirement. Applicant therefore respectfully requests reconsideration of the restriction requirement of the claims, and if no further rejections or objections be forthcoming, issuance of a Notice of Allowance for all originally pending claims.

Applicant respectfully requests the Examiner contact the undersigned attorney of record at (512) 542-2100 if such would further or expedite the prosecution of the present Application.

Respectfully submitted,

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<u>REDACTED CLAIMS</u>

Please cancel Claims 1-4.

1. Canceled

2. Canceled

3. Canceled

4. Canceled

5. (Unchanged) An electronic database used as a depository for electronic documents generated during E-commerce transactions, comprising:

      means for automatically receiving an electronic document after an E-commerce transaction has completed;

      means for generating a document ID for said received E-commerce document; and

      means for storing said electronic document.

6. (Unchanged) The electronic database of Claim 5, wherein said means for generating said document ID further includes means for transmitting said document ID to each party to said E-commerce transaction, which produced said electronic document.

7. (Unchanged) The electronic database of Claim 5, wherein said means for storing further comprises:

3   means for allowing a later read access to said E-commerce document by a party to said E-

4   commerce transaction; and

5   means for preventing modifications to said E-commerce document after it has been stored.

Please cancel Claims 8-10.

8. Canceled

9. Canceled

10. Canceled

1   11. (Unchanged) A depository for ensuring the authenticity of electronic documents generated

2   during E-commerce transactions, said depository comprising:

3   means for enabling automatic receipt of an electronic document, in response to a completion

4   of an E-commerce transaction in which said electronic document is created; and

5   means for storing said electronic document in said electronic depository.

1   12. (Unchanged) The depository of Claim 11, wherein said storing means includes:

2   means for limiting a write access of said electronic document to a first access; and

3   means for restricting subsequent access to said document to read-only access, such that no

4   changes may be made to said electronic document once it has been stored.

1   13. (Unchanged) The depository of Claim 11, further including:

2   means for controlling a read and write access to said electronic depository, wherein said
3   document is stored in a write-once, read-many format;

4   means for generating a document identifier (ID), to identify said electronic document; and

5   means for later retrieving said electronic document for a party to said E-commerce
6   transaction.

1   14. (Unchanged) The depository of Claim 13 wherein said controlling means further includes:

2   means for enabling a non-modification function for said electronic document, wherein a
3   control code of said electronic depository is activated to prevent later modification to said electronic
4   document; and

5   means for flagging electronic document within said electronic depository to allow a later read
6   access to said E-commerce document by a party to said E-commerce transaction.

Please cancel Claims 15-18.

15. Canceled

16. Canceled

17. Canceled

18. Canceled

**BEFORE THE OFFICE OF ENROLLMENT AND DISCIPLINE
UNITED STATE PATENT AND TRADEMARK OFFICE**

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Expires: May 23, 2003

Harry Moatz,
Director of Enrollment and Discipline